

S/N 09/823,201

Response to Office Action Dated 11/17/2004

**REMARKS**

As background information, this Response is submitted in response to the Office Action of 11/17/2004. Claims 1—19 were originally filed. No claims have been added, withdrawn or cancelled. Claim 9 is currently amended. Accordingly, 5 claims 1—19 are currently pending. At this time, all claims are rejected. In view of the following remarks, Applicant respectfully requests reconsideration and allowance of the rejected claims.

Claims 1—19 were rejected by the Office Action mailed 11/17/2004. The Applicant respectfully requests reconsideration and allowance of the claims.

10 **35 U.S.C. §102**

Claims 1—6 were rejected under §102 as being anticipated by U.S. patent application 20040017583, herein after "Kageyama." The Applicant respectfully traverses the rejection.

15 According to the MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

Anticipation is a legal term of art. The applicant notes that in order to provide a valid finding of anticipation, several conditions must be met: (i) the 20 reference must include every element of the claim within the four corners of the reference (see MPEP §2121); (ii) the elements must be set forth as they are recited in the claim (see MPEP §2131); (iii) the teachings of the reference cannot be modified (see MPEP §706.02, stating that "No question of obviousness is present" in conjunction with anticipation); and (iv) the reference must enable the invention

S/N 09/823,201

Response to Office Action Dated 11/17/2004

as recited in the claim (see MPEP §2121.01). Additionally, (v) these conditions must be simultaneously satisfied.

The §102 rejection of claims 1—6 is believed to be in error. Specifically, the PTO and Federal Circuit provide that §102 anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference. *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Applicant notes the requirements of MPEP §2131, which states that “to anticipate a claim, the reference must teach every element of the claim.” This MPEP section further states that “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990)."

Claims 1 recites in part, “writing a document to a file; translating the file, using a procedure, into a sequence of commands for a page description language.”

S/N 09/823,201

Response to Office Action Dated 11/17/2004

The Patent Office suggests that paragraph 0297 of Kageyama discloses “translating the file ... into a sequence of commands for a page description language.” However, a review of 0297 reveals that Kageyama does not disclose “translating,” but does disclose the “transfer the document files” in line 4 of 5 0297. The Applicant maintains that ‘translating’ and ‘transferring’ are not the same process, and that one does not suggest or imply the other. Accordingly, Kageyama’s disclosure of a “transfer” does not suggest, imply or disclose “translation.” Therefore, paragraph 0297 of Kageyama fails to disclose the step of “translating the file,” as recited by claim 1, and instead discloses a “transfer.”

10 Claim 1 additionally recites “using a procedure” for the translation. The Patent Office suggests that paragraph 0297 of Kageyama discloses, “using a procedure” for the translation. However, since paragraph 0297 of Kageyama discloses no translation, it is not clear to which procedure the Patent Office is referring. Kageyama discloses an ‘archive control instruction section’ 3170, but 15 no reference is made describing any “translating” that is done by this section. If the Patent Office persists in suggesting that this paragraph of Kageyama discloses a procedure for translation, the Applicant respectfully requests that the procedure be clearly identified. In paragraph 0223, Kageyama translates *from* PDL (page description language) to an editable format. However, this is not “translating the 20 file” *into* a sequence of commands for a page description language. Thus, Kageyama fails to disclose the recited elements of claim 1.

Claim 1 additionally recites “sending the page description language commands to a page description language interpreter.” The Patent Office suggests that paragraphs 0222 and conversion section 2700 and 2710 seen in Fig. 6 provide

S/N 09/823,201

Response to Office Action Dated 11/17/2004

the functionality recited in the claim. The Applicant respectfully disagrees. In the cited section, Kageyama discloses conversion from PDL (page description language) into a document display and/or editing format. (See Kageyama 0222, first 6 lines.) For example, Kageyama discloses how to translate from PostScript to HTML, XML or PDF. (See Kageyama 0223.) This is not the same as, nor does it suggest, "sending the page description language commands to a page description language interpreter." A 'page description language interpreter' does not translate the page description language into HTML, XML or PDF; instead, such an interpreter "interprets" the statements in the language to create the output (typically called "raster" or "bit-mapped" data) needed by a printer to form print output. Thus, paragraph 0222 of Kageyama does not disclose "sending the page description language commands to a page description language interpreter," and instead discloses translation of the page description language into an editable format. Accordingly, the Applicant respectfully requests that the section 102 rejection of claim 1 be removed, and that this claim be allowed to issue.

Claim 2 recites in part, "receiving an error message in response to an unrecognized command in the document." The Patent Office suggests that the failure reports of paragraph 306 disclose the recited elements. However, Kageyama fails to disclose responding to "an unrecognized command in the document." In fact, Kageyama discloses that *a failure of a file to transfer* could be reported by a 'transfer completion report.' In contrast, the Applicant's claim recites a configuration able to realize that a command is unrecognized, and sends an error report. Therefore, in contrast to the Applicant's recited claim, Kageyama fails to disclose the capacity to distinguish "unrecognized commands." Therefore,

S/N 09/823,201

Response to Office Action Dated 11/17/2004

Kageyama does not disclose the elements recited by claim 2; accordingly, the Applicant respectfully requests that the section 102 rejection be withdrawn.

Claim 3 depends from claim 1, and is allowable by virtue of this dependence, as well as for reasons associated with the element recited therein.

5        Claim 4 recites, in part, "the procedurc is written in the page description language." The Patent Office suggests that paragraph 0297 of Kageyama discloses this aspect. The Applicant respectfully disagrees. Kageyama discloses that documents can be formatted in page description language. In fact, page description language is routinely used as the formatting language of print jobs, and  
10        thereby to direct printers on how to print the information contained in documents. That is, the page description language provides the instructions needed by the printer to generate the 'raster data' that results in printed output. In contrast, what the Applicant's claim recites is that a procedure, which has been written in page description language, is used to translate the incoming document into page  
15        description language. Thus, page description language is being used by the procedure, which is written in page description language, and page description language is *also* being used as the format of the output of the procedure. Thus, the Applicant recites a novel use of page description language. While page description language was intended to format print jobs, the Applicant recites a  
20        novel use of that same language, by using that language to write a procedure to translate a file *into* page description language commands. This is advantageous, since printers already know how to operate page description language. However, Kageyama does not disclose the use of page description language for any purpose other than describing pages to a printer, much less as the basis for a procedure to

S/N 09/823,201

Response to Office Action Dated 11/17/2004

translate a file into page description language. Accordingly, the Applicant respectfully requests that the section 102 rejection of claim 4 be removed, and that this claim be allowed to issue.

Claim 5 depends from claim 4, and is allowable by virtue of this dependence, as well as for reasons associated with the element recited therein.

Claim 6 depends from claim 1, and is allowable by virtue of this dependence, as well as for reasons associated with the element recited therein.

**35 U.S.C. §103**

Claims 7—19 were rejected under section 103(a) as being unpatentable over U.S. patent 5,652,711 (hereinafter “Vennekens”) in view of Kageyama.

Claim 7 recites, in part, “translating the file into a sequence of page description language commands.” Claim 16 recites a similar translation. The Patent Office suggests that paragraph 0297 of Kageyama discloses such a translation. However, paragraph 0297 of Kageyama does not disclose translation in general, and in particular, paragraph 0297 does not disclose translation in response to an unrecognized command in a document to be printed. Lending credence to the notion that paragraph 0297 of Kageyama does not disclose translation, is the fact that no mention is made of the format from which (or to which) the PDL format documents were translated. What paragraph 0297 of Kageyama does disclose is that transfer of documents in a PDL format can be controlled by an archive controller, and that the transfer can be made between a computer and a printer controller. Thus, paragraph 0297 of Kageyama discloses transfer, but not translation.

S/N 09/823,201

Response to Office Action Dated 11/17/2004

The Vennekens reference fails to disclose the concept of errors resulting specifically from unrecognized commands.

Therefore, the elements of claims 7 and 16 are not shown by the prior art. Accordingly, the Applicant respectfully requests that the rejection of claims 7 and 16 be removed, and that these claims be allowed to issue.

Claim 8 depends from claim 7, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 8.

Claim 9 recites, in part, "wherein the procedure is written in the page description language." The arguments from claim 4, above, are incorporated herein by reference. The Kageyama reference discloses no procedures or subroutines that are written in page description language. Instead, Kageyama uses page description language for its convention use, i.e. as a format by which a file to be printed is written. Thus, in a conventional setting—e.g. the Kageyama reference—page description language is used to format a document containing information to be printed. In contrast, the Applicant has recited in claim 9 that page description language has been used as the language with which the procedure that performs the translation is written. The Patent Office points to paragraph 0297 of Kageyama. However, for at least the reasons discussed above, Kageyama does not use page description language as the language with which a procedure is written. (Kageyama uses page description language as the language for files to be printed.) Moreover, Kageyama does not disclose using the procedure to "translate the file into a sequence of page description language commands" (claim 7). Accordingly, the Applicant respectfully requests that the rejection to claim 9 be removed.

S/N 09/823,201

Response to Office Action Dated 11/17/2004

Claim 10 depends from claim 7, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 10.

Claims 11 and 13 were rejected by the Patent Office in the same paragraph, based on section 103 in view of Vennekens and Kageyama. Claims 11 and 13 recite aspects related to handling errors in the course of printing a page description language document. Claim 11 discusses page description languages generally. Claim 13 addresses PostScript in particular, and how a PostScript printer can print a non-PostScript document. Obviously, using conventional systems, sending a non-PostScript document to a PostScript printer would generate errors, and would result in failure. The Applicant's claims reveal how files can be printed despite the generation of errors—such as how a non-PostScript file can be printed by a PostScript printer.

Claim 13 recites, in part, “calling an error handler in response to a non-PostScript command in the non-PostScript document; writing the document to a file; translating the file into a sequence of PostScript commands.”

The Patent Office cites paragraph 0297 of Kageyama as an example of translating the document into PDL commands. However, as we have seen, paragraph 0297 does not disclose actual translation, as evidenced in part by the fact that paragraph 0297 does not disclose from what format the PDL documents are translated.

Neither Vennekens or Kageyama disclose receiving a non-PostScript file, or non-PostScript commands, in a PostScript printer (or similar non-PDL file in a



S/N 09/823,201

Response to Office Action Dated 11/17/2004

PDL printer), generating an error in response, and translating the error-generating file into a sequence of PDL (e.g. PostScript) commands.

Accordingly, the Applicant respectfully requests that the rejections of claims 11 and 13 be removed, and that these claims be allowed to issue.

5        Claim 12 recites, in part, “wherein the translation is performed by a procedure written in the page description language.” The Patent Office cites paragraph 0100 as an example of translation being performed by a procedure written in page description language. The Applicant respectfully disagrees. In fact, paragraph 0100 discloses how a file is written to a spool, including some  
10 information on the format and data written with the file. No translation is disclosed.

The arguments from claims 4 and 9, above, are incorporated herein by reference.

The Applicant points out that claim 12 recites not only translation, but  
15 translation that is performed “by a procedure written in the page description language.” As noted above, this means that the procedure that does the translating is actually written in page description language, which is the language in which the files to be printed are also written. This is a novel situation, and is certainly not disclosed by the Kageyama. Accordingly, the Applicant respectfully requests  
20 that the rejection of claim 12 be removed, and that claim 12 be allowed to issue.

Claim 14 depends from claim 13, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 13.

S/N 09/823,201

Response to Office Action Dated 11/17/2004

Claim 15 depends from claim 13, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 15.

Claim 17 depends from claim 16, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 17.

Claim 18 recites, in part, "wherein the error handler is written in the page description language." The Patent Office cites Vennekens column 5 line 64 to column 6 lines 3 as an example of the recited material.

The arguments from claims 4, 9 and 12, above, are incorporated herein by reference.

Vennekens discloses how page description language coming in can be translated into raster data by a plurality of parallel processors. In the cited paragraph, Vennekens discloses that error handling is present. However, Vennekens does not disclose an error handler (or anything else, for that matter, except the incoming PDL data files) that is written in page description language. Thus, Vennekens uses PDL for what everyone else uses PDL for, that is, a language by which files to be printed may be written. Vennekens does not disclose writing an error handler in the same language that is used to write documents to be printed. Accordingly, the Applicant respectfully requests that the rejection of claim 18 be removed, and that claim 18 be allowed to issue.

Claim 19 depends from claim 16, and is allowable by virtue of that dependence, as well as for reasons associated with the elements recited by claim 19.

S/N 09/823,201

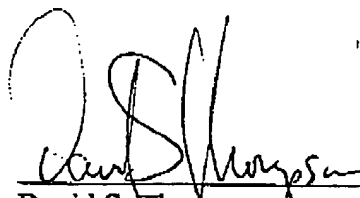
Response to Office Action Dated 11/17/2004

**Conclusion**

The Applicant submits that all of the claims are in condition for allowance and respectfully requests issuance of a Notice of Allowability. If the Office's next anticipated action is not the issuance of a Notice of Allowability, the Applicant respectfully requests scheduling of an interview with the undersigned attorney.

Respectfully Submitted,

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